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In re Application of
Howard Kaplan (deceased)
Application No.: 10/070,503
PCT No.: PCT/CA00/01027
Int. Filing Date: 07 September 2000
Priority Date: 07 September 1999
Attorney Docket no.: 33956-0049
For: ENHANCED PHAGE DISPLAY
LIBRARY OF HUMAN VH FRAGMENTS
AND METHODS FOR PRODUCING

DECISION ON
RENEWED REQUEST
UNDER 37 CFR 1.42

This is a decision on applicant's renewed request under 37 CFR 1.42, filed in the United States Patent and Trademark Office (USPTO) on 24 March 2003.

BACKGROUND

On 07 March 2002, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371 with, *inter alia*, the requisite basic national fee. In response to the Notification of Missing Requirements mailed on 12 June 2002, and to satisfy the requirement that an oath or declaration of the inventors be furnished, applicant filed a declaration on 12 August 2002 that was signed by inventors Joycelyn Entwistle, Jamshid Tanha, Saran Narang, Michael Dan and identifying Carole Grad as legal representative for deceased inventor Howard Kaplan. The submission was treated as a request for status under 37 CFR 1.42.

On 24 December 2002, a decision on applicant's submission was mailed indicating that the declaration was unacceptable because it was not signed by Carole Grad as legal representative for deceased inventor Howard Kaplan and did not clearly state the country of citizenship, former residency and mailing address of both the deceased inventor and the legal representative, as required for compliance with 37 CFR 1.497.

On 24 March 2003, applicant filed the instant renewed request, accompanied by a handwritten alteration to the originally filed declaration and a statement by counsel that the legal representative's refuses to sign the declaration.

DISCUSSION

A review of the amended declaration indicates that the originally filed declaration has been altered to include the addresses of the deceased inventor and his legal representative. The wording of an oath or declaration cannot be amended, altered or changed in any manner after it has been signed. See MPEP 602.01. This declaration is defective since it did not clearly state the country of citizenship, former residency and mailing address of both the deceased inventor

and the legal representative, as required for compliance with 37 CFR 1.497. Thus, it is not in compliance with 37 CFR 1.497 and 1.64.

37 CFR § 1.42 requires that in the case of the death of the inventor, the legal representative of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent. In the circumstance, where the legal representative is uncooperative and refuses to sign the declaration on behalf of the deceased inventor, the proper submission is a petition under 37 CFR 1.47. As stated in MPEP §409(c), 35 CFR 1.47 applies where a known legal representative of a deceased inventor refuses to make application. In such cases, the last known address of the legal representative must be given.


A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s). Applicant is directed to the MPEP §409.03 Unavailability of Inventor for guidance in filing such a petition.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **DISMISSED WITHOUT PREJUDICE.**

Applicant is required to correct the above-noted defects including the furnishing of an oath/declaration in compliance with 37 CFR 1.42 and 1.497 and a petition under 37 CFR 1.47(a) within **TWO (2) MONTHS** from the mail date of this Decision. Failure to respond with a *bona fide* response will result in the abandonment of the application.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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